

REMARKS

Status of the claims:

With the above amendment, claims 1 and 7 have been amended. Claims 1 and 3-13 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Claim 1 has been amended by adding the phrase "a support". Support for this amendment may be found throughout the specification, including originally filed claim 1. Claim 7 has been amended by making claim 7 independent. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §112, first paragraph

Claims 1 and 3-13 have been rejected under 35 USC §112, first paragraph, for allegedly containing "new matter". The Examiner asserts that there is no support in the specification for "the first outermost layer on the first side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the first outermost layer on the first side and the second outermost layer on the second side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the second outermost layer on the second side".

Applicants traverse. Applicants assert that when the specification is read as a whole, it should be readily apparent to

one of ordinary skill in the art that the first outermost layer on the first side and the second outermost layer on the second side can be different. In particular, the Examiner's attention is drawn to page 3, lines 14-16 and page 3, lines 20-33. One of ordinary skill in the art in reading these passages would readily understand that the first outermost layer on the first side and the second outermost layer on the second side can be different.

Furthermore, many of the Examples satisfy the conditions set forth in claim 1. In particular, the Examiner's attention is drawn to Examples 1-2 to 1-7 in Table 1. The Examiner's attention is also drawn to Sample I-1, wherein both the outermost layer on the first side and the outermost layer on the second side contain the same latex. Samples 2-2 to 2-6 in Table 2 of the written description also satisfy the conditions set forth in claim 1. Samples 4-2 to 4-6 in table 4 also satisfy the conditions set forth in claim 1.

Claims 1 and 3-13 have been rejected under 35 USC §112, first paragraph, for allegedly not being completely enabled. The Examiner asserts that the specification does not show how to make and use an image forming layer on both sides of the support. Applicants are not claiming an image forming layer on both sides of the support. There is no indication that there is an image forming image on the second side. Moreover, the Examiner's attention is drawn to page 3, lines 7-9 of the

written description wherein it explicitly states that the image forming material is present on one side. Withdrawal of the rejection is warranted and respectfully requested.

**Rejections under 35 USC §112, second paragraph**

Claims 1 and 3-13 have been rejected under 35 USC §112, second paragraph, as being indefinite. The Examiner asserts that essential elements are omitted from the claims. In particular, the Examiner asserts that the support for the image forming layer and the outermost layers are critical for the thermally processed image forming material. Claim 1 has been amended to include a support. Accordingly, it is submitted that the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Further, the Examiner asserts that the following claim language

*the binder contained in the first outermost layer on the first side and the binder contained in the second outermost layer on the second side have a common monomer composition to a degree less than 75 wt%, and the first outermost layer on the first side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the first outermost layer on the first side and the second outermost layer on the second side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the second outermost layer on the second side*

is indefinite.

In particular, the Examiner asserts that it is unknown if the 75wt% is directed to the use of less than 75 wt% of identical monomer in both the first outermost layer and the second outermost layer. One of ordinary skill in the art would recognize that the binder composition on the outermost layer on one side and the binder composition on the outermost layer on the other side have less than 75 wt% common monomer. By "common", one of ordinary skill in the art would recognize that this means that this is a monomer that is shared "in common" or "the same" monomer. Thus, Applicants assert that there is nothing vague or indefinite about this phrase. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner also asserts that the phrase "to a degree" is vague and indefinite. Applicants have amended "to a degree" so that it now recites "of". It is believed that with this amendment, the claim is no longer vague or indefinite. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner also asserts that "wt%" is also vague and indefinite because it is not stated to what the "wt%" relates. For clarity, Applicants assert that this wt% is relative to the weight of the first outermost layer and the second outermost layer added together. It is believed that with this description, the claim can no longer be considered vague or indefinite. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner also asserts that the "common monomer" is vague and indefinite. As described above, "common monomer" means the monomer in the binder in the first outermost layer on the first side is the same as the monomer contained in the second outermost layer on the second side. As was enumerated above, one of skill would readily recognize this. Withdrawal of the rejection is warranted and respectfully requested.

The Examiner asserts that there is no antecedent basis for the term "the support" in claims 3-9. Claim 1 has been amended so that it contains "a support". It is believed that with this amendment, that there is now antecedent support for "the support" in claims 3-9. Withdrawal of the rejection is warranted and respectfully requested.

#### Claim Objections

The Examiner has objected to claim 7 as being a substantial duplicate of claim 1. Claim 1 and claim 7 are not substantial duplicates of each other. Claim 7 is broader than claim 1 due to the presence of the phrase "wherein the binder contained in the first outermost layer or the binder contained in the second outermost layer on the second side contains a polymer latex in an amount of 50 wt% or more of the total binder". Accordingly, it is not a duplicate of claim 1. Withdrawal of the objection is warranted and respectfully requested.

With the above remarks and amendments, it is believed that the claims, as they now stand, define patentable subject matter such that a passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

Claim 1 (Twice Amended) A thermally processed image forming material having a support, which comprises a first side and a second side wherein

the first side has an image forming layer and a first outermost layer containing a binder and the second side has a second outermost layer containing a binder which is different from the binder of the first outermost layer on the first side,

the binder contained in the first outermost layer on the first side and the binder contained in the second outermost layer on the second side have a common monomer [composition to a degree] of less than 75 wt% wherein the wt% is relative to the weight of the first outermost layer and the second outermost layer added together, and

the first outermost layer on the first side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the first outermost layer on the first side and the second outermost layer on the second side contains a polymer latex in an amount of 50 wt% or more of the total binder contained in the second outermost layer on the second side.

Claim 7 (Amended) [The] A thermally processed image forming material [as claimed in Claim 1,] having a support, which comprises a first side and a second side wherein

the first side has an image forming layer and a first outermost layer containing a binder and the second side has a second outermost layer containing a binder which is different from the binder of the first outermost layer on the first side,

the binder contained in the first outermost layer on the first side and the binder contained in the second outermost layer on the second side have a common monomer of less than 75 wt% wherein the wt% is relative to the weight of the first outermost layer and the second outermost layer added together, and

wherein the binder contained in the first outermost layer [on the same side with the image forming layer] or the binder contained in the second outermost layer on the second side [on the opposite side of the support] contains a polymer latex in an amount of 50 wt% or more of the total binder.